

REMARKS

Claims 1-22 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Information Disclosure Statement:

Applicants note that four different Information Disclosure Statements were submitted on November 11, 2004 (electronically), November 16, 2004 (mailed on November 11, 2004), January 13, 2005 (electronically), and January 25, 2005 (mailed on January 21, 2005), respectively. The IDS of January 25, 2005 was a resubmission of the IDS of November 16, 2004 since the IDS of November 16, 2004 was not signed.

The Examiner indicated that the November 16, 2004 IDS (and presumably the January 25, 2005 IDS) failed to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because an attached Form PTO-1449 was not submitted. This IDS was submitted to reference a pending U.S. patent application (see paragraph 3 on p. 2 of the IDS). M.P.E.P. § 609.III.D clearly states that "Applicants may wish to list U.S. patent application numbers on other than a form PTO-1449 ... to avoid the application numbers of pending applications being published on the patent." Thus, the Examiner is incorrect that a form PTO-1449 was required. According to M.P.E.P. § 609.III.C(2), "[i]f the citations are submitted on a list other than a form PTO-1449 ... the examiner may write "all considered" and his or her initials to indicate that all citations have been considered." Therefore, Applicants request that the Examiner carefully consider the pending application referenced in this IDS and return an indication that the pending application has been considered.

Applicants also respectfully request the Examiner to carefully consider the references listed in the electronic IDS submissions of November 11, 2004 and January 13, 2005, and return signed and initialed copies of the appropriate forms. Copies of the

previously submitted electronic IDSs are included herewith for the Examiner's convenience.

Section 102 Rejections:

Section 4 of the Office Action rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by Huff et al. (U.S. Patent 4,383,298) (hereinafter "Huff"). Applicants respectfully traverse this rejection in light of the following remarks.

Huff does not disclose a computer implemented procurement module for processing both purchase order requisitions for goods and timecard information for services, the procurement module comprising: a buyer module for receiving information related to contract services and for generating an electronic timecard in response thereto, and a timecard module receiving electronic timecards from the buyer module and for generating a purchase order based on approved electronic timecards, the purchase order for use in generating a payment for the contractor services. Instead, Huff teaches a data base complex for storing information pertaining to various aspects of plant maintenance (Huff -- Abstract). The time cards mentioned in Huff (e.g., col. 6, lines 4-11) are physical (i.e. paper) time cards. Huff teaches that information from physical time cards may be entered into the database for use by a maintenance analyst in analyzing new maintenance requests (e.g., col. 6, lines 24-45). However, Huff does not teach generating an *electronic timecard* in response to receiving information related to contract services. Nor does Huff teach generating a purchase order based on approved electronic timecards. There is no mention at all in Huff in regard to approving an electronic timecard. Moreover, the only purchase orders mentioned in Huff pertain to purchasing materials needed for a plant maintenance repair job (col. 6, lines 46-55). The purchase orders mentioned in Huff are clearly not based on approved electronic timecards.

The Examiner argues that the system of Huff includes "SUBMOD that generates labor time card, purchase orders, the repair history cards, the actual job scheduling and working being indicated in state 20 in the flowchart of FIG. 1". Applicants disagree with

the Examiner's interpretation of Huff. At column 4, lines 46-50, Huff defines the term "SUBMOD" as "a functional group of components such as a pump and the motor which drives the pump, which group is assigned a service number." Thus, SUBMOD clearly refers to materials to be purchased in Huff. Therefore, Huff's SUBMOD cannot be considered a procurement module comprising a buyer module for generating an electronic timecard. Nowhere does Huff mention generating an electronic timecard. Instead, Huff only mentions that estimate labor expenses may be included in Huff's database complex 60 to support subsequent queries by a maintenance analyst "so that he can have a complete detailed breakdown of all past maintenance repairs performed" (Huff, column 6, line 63-column 7, line 10; and column 6, lines 12-23).

In the response to arguments section of the Office Action, the Examiner argues that Huff anticipates a computer implemented buyer module for generating electronic timecards and for generating purchase orders based on approved electronic timecards. In support of this assertion, the Examiner states that Huff discloses a system to provide on-line editing and updating of maintenance request orders and further discloses a program by which inquiries can be made concerning detail information about the maintenance labor used to support a maintenance request. The functions of Huff's system cited by the Examiner have no relevance to the generation of electronic timecards and purchase orders based on approved electronic timecards.

For at least the reasons give above, the rejection of claim 1 is not supported by the cited prior art and removal thereof is respectfully requested.

Section 5 of the Office Action rejected claims 1-22 under 35 U.S.C. § 102(e) as being anticipated by Haney (U.S. Publication 2001/0051889). Applicants respectfully traverse this rejection in light of the following remarks.

Haney fails to disclose a computer implemented procurement module for processing both purchase order requisitions for goods and timecard information for

services. In contrast, Haney teaches a computer implemented system that pertains *solely to managing contract labor services*. The system of Haney has absolutely nothing to do with the procurement of goods (something manufactured or produced for sale).

As discussed in Applicants' Related Art section on p. 1 of the specification, existing computer controlled software systems that provide for the management of contract labor are stand-alone programs dedicated solely to the management of contract labor services. Haney is exactly the type of prior art referred to in Applicants' Related Art section. Haney's computer implemented system pertains solely to managing contract labor services. In contrast, Applicants' invention involves the integration of contract labor services management with a procurement system for procuring goods. Applicants' invention treats the contractor as a buyer requesting a purchase order for goods, but the buyer is requesting a purchase order in payment for his time worked. This allows the same approval process normally used for approving purchase requests for goods to also be used for approving the contractor's request for payment. Note that treating a contractor as a buyer is completely counter-intuitive from how the prior art manages contractor services. The prior art, such as Haney, treats contractors as vendors, not buyers. In prior art contractor management systems, such as Haney, the organization hiring the contractor is considered to be the buyer. By reversing these roles, Applicants' invention allows the same procurement system that is used for procurement of goods to be used for managing contractor services. Such a system is not taught or suggested by any of the references cited by the Examiner.

In the Response to Arguments section of the Office Action, the Examiner argues that Haney's system for managing contract labor activities is capable of performing both of the above stated tasks. The Examiner's asserts if the prior art is capable of performing the claimed function – even if not directly disclosed – it anticipates. The Examiner cites *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). However, in *Schreiber* the court found that the limitations at issue were “inherent in the prior art reference.” Contrary to the situation in *Schreiber*, the limitations of claim 1 are not inherent in Haney. The software of Haney's computer system does not function the

same as recited in claim 1. The Examiner also refers to the old case *In re Casey*, 370 F.2d 576, 152 USPQ 235, 238 (CCPA 1967) to support his assertion that the limitations “for goods” and “for services” are functional or intended use language. First of all, “functional limitations” are not the same as intended use language. The courts have made this very clear, as further explained below. The case *In re Casey* pertains to a machine that, in its intended use, works upon a specific material. The court in *Casey* noted that the machine of the prior art had the same structure as the claimed machine and was capable of working on the same material. However, the computer programmed as described in Haney is not capable of functioning as recited in claim 1. Moreover, M.P.E.P. § 2115 states that the holding of *In re Casey* “is limited to claims directed to machinery which works upon an article or material in its intended use.” Thus, the Examiner’s reliance on *Casey* is misplaced.

According to M.P.E.P. § 2173.05(g), “[a] functional limitation must be evaluated and considered, just like any other limitation of the claim” (emphasis added). The courts have held that a functional claim limitation was “perfectly acceptable [to distinguish over the prior art] because it set definite boundaries on the patent protection sought.” *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971). The Examiner has provided no evidence showing that Haney’s system is capable of processing both purchase order requisitions for goods and timecard information for services. Nothing in Haney states or even implies that Haney’s system is capable of processing both purchase order requisitions for goods and timecard information for services. Disregarding specific software instructions, a computer system may be capable of performing a nearly infinite number and variety of functions, but it clearly does not anticipate the infinite number and variety of functions. A computer system configured with a specific set of software instructions (such as in Haney) is configured to perform only a finite set of functions (the functions described in Haney). The Examiner’s assertions that Haney’s computer system anticipates a computer implemented procurement module for processing both purchase order requisitions and timecard information, even though no evidence is present that Haney’s system is configured to operate on purchase order requisitions, is clearly an

incorrect application of Haney. Haney's system does not include structure capable of functioning as recited in claim 1. Therefore, Haney cannot be said to anticipate claim 1.

For at least the reasons give above, the rejection of claim 1 is not supported by the prior art and removal thereof is respectfully requested. Similar remarks as those above regarding claim 1 also apply in regard to independent claims 11 and 17.

In regard to claim 7, Haney does not teach an external report generating module for generating information to be used by external applications and wherein the information is formatted using XML data. The Examiner refers to paragraph [0036] in Haney, which describes his system as web-based, using E-mail and a web browser. However, this portion of Haney does not mention anything regarding an external application using information *formatted in XML*.

In the response to arguments section of the Office Action, the Examiner states that a web browser is software that lets a user view HTML documents and that both HTML and XML are markup languages. However, Haney teaches that a web browser may be used to "present information" (Haney, paragraph [0036]). Nowhere does Haney describe an external report generating module generating information formatted using XML data.

Furthermore, the use of XML is not inherent in Haney. "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). The use of XML is not "necessarily present" or required in all web browser software. Therefore, Haney clearly cannot be said to anticipate claim 7.

Thus, the rejection of claim 7 is not supported by the prior art and removal thereof is respectfully requested. Similar remarks as those above regarding claim 7 also apply in regard to claims 16 and 22.

With regard to claim 8, Haney does not teach an electronic timecard comprising a plurality of line items describing said contractor services including: a contractor identification; a description of serves rendered; an amount of hours performed for said services rendered; an hourly rate for the hours; and subtotals representing said amount of hours by said hourly rate. The Examiner refers to Haney's FIG. 6, which indicates fields such as Vendor Name, Consultant Name, Social Security Number, etc. However, FIG. 6 of Haney does not indicate several of the specifically listed information fields such as a description of serves rendered, an hourly rate for the hours and subtotals representing said amount of hours by said hourly rate.

Thus, for at least the reasons given above, the rejection of claim 8 is not supported by the prior art and removal thereof is respectfully requested.

Regarding to claim 9, Haney does not teach a contractor profile for a contractor, said contractor profile comprising: a contractor identification; authorized projects for said contractor; authorized work types for said contractor; an authorized hourly rate for said contractor; and an approver for said contractor. The Examiner refers to FIG. 4 and paragraphs [0049-51] in Haney. Haney's FIG. 4 depicts his contract labor request form including fields such as CLROrder No., Manager, Location, Phone Number, etc. However, none of the cited portions of Haney mention a contractor profile or the specific listed information fields: contractor identification; authorized projects for said contractor; authorized work types for said contractor; an authorized hourly rate for said contractor; and an approver for said contractor. Thus, for at least the reasons given above, the rejection of claim 9 is not supported by the prior art and removal thereof is respectfully requested.

In regard to claim 10, Haney does not teach an approval notification comprising information from the electronic timecard and an accounting code associated with each line item of the electronic timecard. The Examiner refers to fields 614-616 of FIG. 6 in Haney. However at paragraph [0054], Haney states that fields 614-616 of FIG. 6 of the

time sheet form contain *account codes* for a particular project, and FIG. 6 clearly shows a plurality of work segment line items. Therefore, there is no teaching in Haney regarding an accounting code *associated with each line item* of an electronic timecard. For at least the reasons given above, the rejection of claim 10 is not supported by the prior art and removal thereof is respectfully requested. Similar arguments also apply in regard to claims 15 and 21.

Applicants also assert that the rejection of numerous other ones of the dependent claims is further unsupported by the cited art. However, since the rejections have been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time.

CONCLUSION

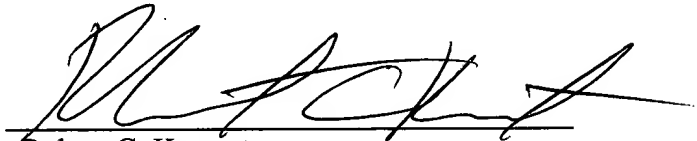
Applicants submit the application is in condition for allowance, and notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-90600/RCK.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☒ Other: Copies of electronic IDSs previously submitted on 11/11/04 and 01/13/05.

Respectfully submitted,



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